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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/509,779 03/29/00 SUN

Y 5650-01-MJA

EXAMINER

HM12/0928

MICHAEL J ATKINS  
WARNER LAMBERT COMPANY  
2800 PLYMOUTH ROAD  
ANN ARBOR MI 48105

HUNT, J

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

09/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.

09/509,779

Applicant(s)

SUN, YI

Examiner

Jennifer E Hunt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-37 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-17, and 25-26, or 32 drawn to a SAG polynucleotide, corresponding vectors, and host cells, and a method of using such to detect SAG mutations.

Group II, claim(s) 18-22, and 33-34, drawn to a polypeptide.

Group III, claim(s) 23, drawn to an antibody which binds SAG.

Group IV, claim(s) 24, drawn to a method of detecting SAG protein.

Group V, claim(s) 27-28, drawn to a method of isolating RNA using SAG.

Group VI, claim(s) 29, drawn to a method of isolating genes induced during apoptosis.

Group VII, claim(s) 30, drawn to a method for protecting cells from apoptosis.

Group VIII, claim(s) 31, drawn to a method of inhibiting growth of tumor cells.

Group IX, claim(s) 35, drawn to a method of oxygen radical scavenging.

Group X, claim(s) 36, drawn to a method of promoting wound healing.

Group XI, claim(s) 37, drawn to a method of promoting or inhibiting plant growth.

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The inventions listed as Groups I-XI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

An international application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) a product and process specially adapted for the manufacture of said product; or
- (2) a product and a process of use of said product; or
- (3) a product, a process specially adapted for the manufacture of said product, and a process of use of said product; or
- (4) a process and an apparatus or means specifically designed for carrying out the process; or
- (5) a product, a process specially adapted for the manufacture of said product, and an apparatus or means specifically designed for carrying out the process.

In the instant case, Group I contains a product (a SAG nucleic acid molecule and corresponding vectors and host cells), and a process of use of the product (a diagnostic assay for detecting SAG mutations). The products and methods of Groups II-XI are distinct from the methods of Group I for the reasons set forth below:

Group II is drawn to a polypeptide product. Group III is drawn to an antibody product. The products of Groups I-II are distinct because the nucleic acid molecule of Group I, the polypeptide of Group II and the antibody of Group III have completely different structures, physical properties, and physiological functions.

Group IV is drawn to a method of detecting SAG protein. Group V is drawn to a method of isolating RNA using SAG. Group VI is drawn to a method of isolating genes induced during apoptosis. Group VII is drawn to a method for protecting cells from apoptosis. Group VIII is drawn to a method of inhibiting growth of tumor cells. Group IX is drawn to a method of oxygen radical scavenging. Group X is drawn to a method of promoting wound healing. Group XI is drawn to a method of promoting or inhibiting

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plant growth. These are distinct methods, having different starting points, distinct method steps, and different outcomes.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

If Group I, VII-VIII, X or XI is elected, applicant must further elect a species of polynucleotide encoding a SAG mutant from the Group consisting of SEQ ID NO:1, 3, 11, 13, 21, 23, 25, 27, 29, 31, 33, 35, 37, 39, 41, 43, 45, 47, and 49.

These are distinct species of polynucleotides which require separate searches and grounds of consideration.

If Group II-V, or IX is elected, applicant must further elects a species of SAG mutant from the Group consisting of SEQ ID NO:2, 4, 12, 14, 22, 24, 26, 28, 30, 32, 34, 36, 38, 40, 42, 44, 46, 48, and 50.

These are distinct species of polypeptides which require separate searches and grounds of consideration.

If Group V is elected, applicant must further elect a species of RNA stretch:

A) polyA and polyC

B) polyU

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These are distinct species of RNA stretches, requiring distinct searches and grounds of consideration.

If Group XI is elected, applicant must further elect a species of altering plant growth:

C) Where plant growth is promoted

D) Where plant growth is inhibited

These are distinct activities, activated by different mechanisms and having opposite effects.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the reasons set forth above.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E Hunt whose telephone number is (703) 308-7548. The examiner can normally be reached on Monday-Friday, 6-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on (703) 308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0196.

Jennifer E Hunt  
Examiner  
Art Unit 1642

jeh  
September 26, 2001

  
ANTHONY C. CAPUTA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600